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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,042	04/08/2004	Sylvain Baratin	11016-0027	7324
22902 7590 05/17/2007 CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			EXAMINER STRIMBU, GREGORY J	
			ART UNIT 3634	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,042	<b>Applicant(s)</b> BARATIN ET AL.	
	<b>Examiner</b> Gregory J. Strimbu	<b>Art Unit</b> 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Drawings***

The drawing correction filed November 22, 2006 and April 20, 2007 have been approved.

### ***Specification***

The disclosure is objected to because the description of figures 8 and 9 on page 4 is inadequate since each figure is not described separately. Recitations such as "h" on line 33 of page 6 should be changed to --h--. The amendment to line 30 of page 5 could not be entered since no paragraph begins on line 30 of page 5.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification lacks antecedent basis for the claim terminology in claim 13. Although lines 6-10 of page 2 set forth to a drum, pallet, or in a container, this section of the specification is referring to the prior art. Therefore, the specification lacks antecedent basis for the subject matter of claim 13 because the characteristics of the prior art cannot be automatically attributed to the instant invention. It is suggested the applicant amend the Objects and Summary of the Invention section or the More Detailed Description section to include the drum, pallet, or in a container to overcome the objection.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as “[a] combination of a sealing gasket for mounting on a support that is to receive it, on a motor vehicle door designed to close a vehicle body work zone and of said support” on lines 1-3 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. It appears that the applicant is attempting to recite the combination of the gasket and the support, however, the recitation “for mounting on a support” implies that the combination is not being recited. If the combination is indeed to be claimed, then it is suggested the applicant amend claim 1 to recite --A combination of a sealing gasket and a support of a motor vehicle door for closing a vehicle bodywork zone,-- to avoid confusion.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 7, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al. '839. Kawai et al. '839 discloses a sealing gasket 14 for mounting on a support 12 that is to receive it, on a motor vehicle door designed to close

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a bodywork zone of a vehicle, the support presenting at least one corner of small radius of curvature as shown in the bottom left hand corner of figure 1, the gasket 14 comprising at least a flexible or semi-rigid fixing portion 15 fixed to the support by an adhesive 18 as shown in figure 3, and an elastically-deformable tubular portion 17 for providing sealing, the elastically-deformable portion having a non-deformed cross-section in a free state and a deformed cross-section in a deformed state as shown in figure 6 which is due to a corner of the support, wherein once the gasket has been mounted on its support, said deformed cross-section occupies an area which is substantially within that area occupied by said non-deformed cross-section which is shown when comparing the cross section of the gasket in figures 5 and 6, the elastically-deformable portion 17 of the gasket 14 is given a shape extending from its fixing portion that is substantially triangular as shown in figure 6, with two lateral pillars (not numbered, but shown in figure 6 forming the sides of the deformable portion 17) united with each other by an arch (not numbered, but shown in figure 6) and forming between the two lateral pillars, an angle of about  $10^{\circ}$  to  $30^{\circ}$  as shown in figure 6, said angle being defined using two straight lines passing substantially through the middles of the pillars at  $2/5$ ths and at  $4/5$ ths of the total height of the gasket measured from its fixing portion, the arch has a reduced thickness, the fixing portion 15 includes bearing portions (not numbered, but shown in figure 6) on opposite sides of the adhesive, said elastically-deformable portion of the gasket includes a base portion (not numbered, but shown in figure 5) which is connected thereto at one end thereof since both ends are connected thereto.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. '839 as applied to claims 1, 2, 6, 7, 11 and 12 above. Kawai et al. '839 is silent concerning an angle of 20 degrees.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the angle between the two pillars with a value of approximately 20 degrees.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. '839 as applied to claims 1, 2, 6, 7, 11 and 12 above. Kawai et al. '839 is silent concerning the distance between the inner and outer top portions of the arch of the elastically deformable portion.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design

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choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the inner and outer portions of the arch of the elastically deformable portion with a distance greater than 0.7 mm.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. '839 as applied to claims 1, 2, 6, 7, 11 and 12 above. Kawai et al. '839 is silent concerning reduced gasket height at a corner having a small radius of curvature.

However, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the gasket with a reduced height at a corner having a small radius of curvature no greater than 2.5mm.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. '839 as applied to claims 1, 2, 6, 7, 11 and 12 above, and further in view of Weimar. Weimar discloses a reinforcement 20 in a fixing portion 4 of a gasket.

It would have been obvious to one of ordinary skill in the art to provide Kawai et al. '839 with a reinforcement, as taught by Weimar, to increase the strength of the fixing portion.

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Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. '839 as applied to claims 1, 2, 6, 7, 11 and 12 above, and further in view of Shields. Shields discloses a gasket 10 including a means 31 for weakening the compressibility forces of the gasket.

It would have been obvious to one of ordinary skill in the art to provide Kawai et al. '839 with a weakening means, as taught by Shields, to more accurately control the compressibility of the gasket.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. '839 as applied to claims 1, 2, 6, 7, 11 and 12 above, and further in view of Hess et al. Hess et al. discloses the use of a spool 20 for supplying a gasket 10 to an assembly line.

It would have been obvious to one of ordinary skill in the art to provide the gasket of Kawai et al. '839 to an assembly line on a spool, as taught by Hess et al., to save space along the assembly line.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al. '839 as applied to claims 1, 2, 6, 7, 11 and 12 above, and further in view of Masuda et al. (US 2005/0155294). Masuda et al., in figure 6, discloses a sealing gasket in combination with a support 110 wherein an elastically-deformable portion of the gasket 102 includes a base portion (not numbered, but shown in figure 6 above the head of the



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clip 111) which extends substantially parallel to a fixing portion (not numbered, but shown in figure 6 below the head of the clip 111).

It would have been obvious to one of ordinary skill in the art to provide Kawai et al. with mounting system, as taught by Masuda et al., to more securely mount the gasket to the frame.

### ***Response to Arguments***

Applicant's arguments filed April 20, 2007 have been fully considered but they are not persuasive. With respect to the applicant's comments concerning Kawai et al., the examiner respectfully disagrees. Kawai et al. teaches a single part gasket 14 formed by extrusion comprising a single part without any interconnection. The gasket 14 merely has its ends connected together by the molding section 13 as set forth in column 5, lines 2-3.

The applicant's comments concerning claim 14 are moot in view of the new grounds of rejection.

### ***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
May 14, 2007